



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/521,704	01/19/2005	Balthasar Antonius Gerardus Van Luijt	NL 020671	2624
21186 7590 10/17/2008 SCHWEGMAN, LUNDBERG & WOESSNER, P.A. P.O. BOX 2938 MINNEAPOLIS, MN 55402				
EXAMINER				
JOO, JOSHUA				
ART UNIT		PAPER NUMBER		
2454				
MAIL DATE		DELIVERY MODE		
10/17/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/521,704

**Applicant(s)**

VAN LUIJT ET AL.

**Examiner**

JOSHUA JOO

**Art Unit**

2454

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 August 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,7-9,11 and 13-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,7-9,11 and 13-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 January 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Detailed Action***

1. This Office action is in response to communication dated 08/13/2008.

Claims 1, 3, 7-9, 11, 13-17 are pending for examination.

**Continued Examination Under 37 CFR 1.114**

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(c), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(c) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 07/23/2008 has been entered.

**Drawings**

3. The drawings are objected to because the drawings should be provided with descriptive text labels.

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the amended features of claims 1, 3, 13, and 14 and amended features from the claim dated 02/18/2008 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief

description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

#### **Response to Arguments**

4. Applicant's arguments with respect to claims 1, 3, 7-9, 11, 13-17 have been considered but are moot in view of the new ground(s) of rejection. New ground(s) of rejection are necessitated by Applicant's amendment. Applicant argued that:
5. Applicant respectfully traverses the Office action's rejection because the meaning of "machine-readable medium" is not unclear. According to the MPEP, "the failure to provide explicit antecedent basis for terms does not always render a claim indefinite".
6. In response, it is respectfully noted that the claim was not rejected for the reason that the meaning of "machine-readable medium" is not clear or indefinite. Rather, the specification was objected to because the specification does not provide proper antecedent basis for the term "machine-readable medium". Terms and phrases should find clear support or antecedent basis in the specification. Applicant contends that the "machine-readable medium" is clear in the context of the specification, which references "storage mediums". Applicant is required to make appropriate amendment to the description to include "machine-readable medium" as corresponding to "storage mediums" provided no new matter is introduced. See MPEP 608.01(n).

**Claim Rejections - 35 USC § 101**

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 3, 7-9, 14-17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

9. Regarding claim 3, Applicant is seeking to patent a device comprising of “means for” for performing functions. According to Applicant’s specification, Applicant intends for the means to comprise software means (See Page 4, lines 4-7; page 6, lines 13-15, 27-29), and therefore, the claimed device is directed to a software device. A software device does not meet one of the four categories of invention and is not statutory. Specifically, software is not a series of steps or acts and thus is not a process. Software is not a physical article or object and as such is not a machine or manufacture. Software is not a combination of substances and therefore not a composition of matter.

10. Regarding claim 13, Applicant is seeking to patent a device comprising only modules. Modules are software (Also see specification page 4, lines 4-7; page 6, lines 13-15, 27-29), and therefore, the claimed device is directed to a software device. A software device does not meet one of the four categories of invention and is not statutory. Specifically, software is not a series of steps or acts and thus is not a process. Software is not a physical article or object and as such is not a machine or manufacture. Software is not a combination of substances and therefore not a composition of matter.

**Claim Rejections - 35 USC § 112**

11. Claim 13 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

12. Claim 13's machine-readable medium that performs the method of transmitting registered usage information to a third party; billing a user of the device; recording user profile information; and crediting a bill the amount with a sum upon receipt of the user profile is not described in Applicant's specification. According to Applicant's specification, the register usage information is transmitted to a third party and the third party bills the user of the clients (page 6, lines 5-8; page 8, lines 24-27). Furthermore according to Applicant's specification, the third party credits the user on the bill of the user (page 3, lines 22-26). However, according to claim 13, the machine-readable performs a function of both a client and the third party by transmitting registered usage information and the user profile information to itself, i.e. transmit the registered usage information and record user profile information, and credit a bill upon receipt of the recorded user profile with the registered usage information. A machine-readable medium as claimed is not described in Applicant's specification.

#### **Claim Rejections - 35 USC § 103**

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 1 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy et al. US Publication #2007/0294173 (Levy hereinafter), in view of Barnes, JR. US Publication #2007/0173266 (Barnes hereinafter).

15. As per claim 1, Levy teaches substantially the invention as claimed including a method of regulating sharing of a multimedia object by a device, the method comprising:

registering usage information for the multimedia object upon sharing the multimedia object (Paragraphs 0057; 0061. Register usage. Paragraph 0011. Usage includes copying and distributing of content.);

transmitting the registered usage information to allow billing of a user of the device for an amount in accordance with the registered usage information for the multimedia object (Paragraph 0057; 0061. Report usage for billing.);

a recorded user profile information to allow crediting of a bill for the amount with a sum, upon receipt of the recorded user profile information and the registered usage information (Paragraph 0057. Establish account with billing system to facilitate billing for usage of content.).

16. Levy does not specifically teach of recording user profile information for the user, the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user and transmitting the recorded user profile information to allow crediting of a bill for the amount with a sum, upon receipt of the recorded user profile information together with the registered usage information.

17. Barnes teaches of recording user profile information for the user, the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user; and transmitting the recorded user profile information to allow crediting of a bill for a amount with a sum, upon receipt of the recorded user profile information (Paragraphs 0234-0235. Receive indication that user has view the advertisement and credit funds to an account or reduce fee.)

18. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to record user profile information for the user, the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user; and transmit the recorded user profile information to allow crediting of a bill for a amount with a sum, upon receipt of the recorded user profile information as taught by Barnes with the registered usage

information as taught by Levy. The motivation for the suggested combination is that Barnes' teachings would provide an improvement to Levy's teachings by providing incentive to users to view advertisements as suggested by Barnes.

19. As per claim 13, Levy teaches substantially the invention as claimed including a machine-readable medium containing instructions that when executed by a processing system, causing the processing system to perform a method of regulating sharing of a multimedia object by a device, the method comprising:

registering the usage information for the multimedia object upon sharing of the multimedia object, the registering of the usage information including obtaining an identifier from metadata associated with the multimedia object (Paragraphs 0057; 0061. Register usage along with unique ID. Paragraph 0011. Usage includes copying and distributing of content.);

transmitting the registered usage information to a third party when the registered usage information meets a predetermined criterion (Paragraph 0057; 0061. Report usage.);

billing a user of the device for an amount in accordance with the registered usage information for the multimedia object (Paragraph 0057; 0061. Report usage. Bill for the usage of content.); and

recording user profile information for the user (Paragraph 0057. Establish account with billing system.).

20. Levy does not specifically teach of the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user; and crediting a bill for the amount with a sum, upon receipt of the recorded user profile information and the register usage information.

21. Barnes teaches of recording user profile information for the user, the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user; and transmitting the recorded user profile information to allow crediting of a bill for a amount with a sum,



upon receipt of the recorded user profile information (Paragraphs 0234-0235. Receive indication that user has view the advertisement and credit funds to an account or reduce fee.)

22. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to record user profile information for the user, the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user; and crediting of a bill for a amount with a sum, upon receipt of the recorded user profile information as taught by Barnes with the registered usage information as taught by Levy. The motivation for the suggested combination is that Barnes' teachings would provide an improvement to Levy's teachings by providing incentive to users to view advertisements as suggested by Barnes.

23. Claims 3, 8, 14, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy, in view of Levy, US Publication #2002/0052885 (Levy '2002/0052885 hereinafter) and Ishibashi, US Patent #7,353,541 (Ishibashi hereinafter), and Barnes.

24. As per claim 3, Levy teaches substantially the invention as claimed including a device arranged for sharing of a multimedia object, comprising:

file sharing means for sharing the multimedia object with other devices (Paragraphs 0011; 0057. Usage of content includes copying and distributing of content.);

identifying means for obtaining an identifier for the multimedia object being shared (Paragraph 0057; 0062. Identify unique ID. Paragraph 0052. Unique ID may be a digital watermark.);

accounting means for registering usage information for the identified multimedia object (Paragraphs 0057; 0061. Register usage for reporting.);

reporting means for transmitting the registered usage information to a third party when the registered usage information meets a predetermined criterion, to allow afterwards, billing for sharing of

the multimedia object in accordance with the registered usage information for the multimedia object (Paragraph 0057; 0061. Report usage for billing.).

25. Levy does not specifically teach of the identifying means comprising a fingerprint calculator to obtain the identifier by computing a fingerprint for at least a portion of the multimedia object; wherein the device is to inhibit sharing of the multimedia object in response to the reporting means failing to transmit the registered usage information to the third party; and user profile maintenance means for maintaining user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user.

26. Levy '2002/0052885 teaches of registering sharing of the multimedia with other devices (Paragraphs 0032-0033) and obtaining an identifier by computing a fingerprint for at least a portion of the multimedia object (Paragraphs 0046; 0111; 0114).

27. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to utilize obtain the identifier by computing a fingerprint for at least a portion of the multimedia object. The motivation for the suggested combination is that Levy '2002/0052885's teachings would provide an improvement to Levy's teachings by allowing verification that a file is complete as suggested by Levy '2002/0052885.

28. Ishibashi teaches a similar system for maintaining utilization history of content, wherein a device is arranged to inhibit sharing of the multimedia object in response to the reporting means failing to transmit information used to determine usage fee to the third party (col. 20, lines 54-58; col. 97, lines 35-50. Detect charge information is uncollected and prevent reproduction of content.).

29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to inhibit sharing of the multimedia object in response to the reporting means failing to transmit the information to the third party. The motivation for the suggested combination is that

Ishibashi's teachings would provide an improvement to the suggested system by limiting the reproduction of content.

30. Barnes teaches of maintaining user profile information for the user, the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user (Paragraphs 0234-0235. Receive indication that user has view the advertisement and credit funds to an account or reduce fee.)

31. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to maintain a user profile information for the user, the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user. The motivation for the suggested combination is that Barnes' teachings would provide an improvement to the suggested system by providing incentive to users to view advertisements as suggested by Barnes.

32. As per claim 14, Levy teaches substantially the invention as claimed including a device to share a multimedia object, the device comprising:

a file sharing module to share the multimedia object with other devices (Paragraphs 0011; 0057. Usage of content includes copying and distributing of content.);

an accounting module to register usage information for the multimedia object, based on the identifier (Paragraphs 0057; 0061. Register usage for reporting.);

a reporting module to transmit registered usage information to a third party based on the registered usage information meeting a predetermined criterion to allow billing for sharing of the multimedia object in accordance with the registered usage information (Paragraph 0057; 0061. Report usage for billing.).

33. Levy does not specifically teach a fingerprinting module including a fingerprint calculator to obtain an identifier for the multimedia object by computing a fingerprint for at least a portion of the

multimedia object; the device to inhibit sharing of the multimedia object in response to the reporting means failing to transmit the registered usage information to the third party; and a user profile maintenance module to maintain user profile information associated with at least one of browsing behavior of the user and a multimedia interested of the user.

34. Levy '2002/0052885 teaches of registering sharing of the multimedia with other devices (Paragraphs 0032-0033) and obtaining an identifier by computing a fingerprint for at least a portion of the multimedia object (Paragraphs 0046; 0111; 0114).

35. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to utilize obtain the identifier by computing a fingerprint for at least a portion of the multimedia object. The motivation for the suggested combination is that Levy '2002/0052885's teachings would provide an improvement to Levy's teachings by allowing verification that a file is complete as suggested by Levy '2002/0052885.

36. Ishibashi teaches a similar system for maintaining utilization history of content, wherein a device is arranged to inhibit sharing of the multimedia object in response to the reporting means failing to transmit information used to determine usage fee to the third party (col. 20, lines 54-58; col. 97, lines 35-50. Detect charge information is uncollected and prevent reproduction of content.).

37. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to inhibit sharing of the multimedia object in response to the reporting means failing to transmit information to the third party. The motivation for the suggested combination is that Ishibashi's teachings would provide an improvement to the suggested system by controlling the reproduction of content.

38. Barnes teaches of maintaining user profile information for the user, the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user

(Paragraphs 0234-0235. Receive indication that user has view the advertisement and credit funds to an account or reduce fee.)

39. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings to maintain a user profile information for the user, the user profile information associated with at least one of browsing behavior of the user and a multimedia interest of the user. The motivation for the suggested combination is that Barnes' teachings would provide an improvement to the suggested system by providing incentive to users to view advertisements as suggested by Barnes.

40. As per claims 8 and 16, Levy teaches the device of claims 3 and 14, in which the usage being registered for the multimedia object comprises a length of the multimedia object (Paragraph 0061. Determine amount of usage by detecting watermarks embedded in video frames, e.g. 1 second interval. Determine content is watched one and a half times.).

41. Claims 7 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy, Levy '2002/0052885, Ishibashi, and Barnes, in view of Sako et al. US Patent #7,062,467 (Sako hereinafter)

42. As per claims 7 and 15, Levy teaches the device of claims 3 and 14 including usage information including sharing of multimedia object. Levy does not specifically teach that the usage information being registered for the multimedia object comprises a number of times the multimedia object is being shared.

43. Sako teaches of registering a number of times content is shared (Abstract; col.1, lines 60-67; claim 21).

44. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the usage information for the multimedia object as taught by Levy to comprise a number of times content is being shared as taught by Sako. The motivation for the suggested

combination is that Sako's teachings would provide an improvement to the suggested system by providing a specific basis for billing and allowing billing of content that actually reflects the usage of content by a user.

45. Claims 9 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Levy, Levy '2002/0052885, Ishibashi, and Barnes, in view of Kutaragi et al. US Patent #7,275,261 (Kutaragi hereinafter)

46. As per claims 9 and 17, Levy teaches of sharing multimedia object but does not specifically teach the device of claims 3 and 14 in which the predetermined criterion comprises a predetermined number of times the multimedia object as been shared.

47. Kutaragi teaches of monitoring utilizing condition of content, wherein utilization history is transmitted when a number of times of utilizing content exceeds a predetermined number (claim 4).

48. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings for the predetermined criteria to comprise a predetermined number of times the multimedia object is utilized. The motivation for the suggested combination is that Kutaragi's teachings would provide an improvement to the suggested system by enabling automatically reporting of usage information for billing for the usage of content as suggested by Kutaragi.

### **Conclusion**

49. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

50. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Joo whose telephone number is 571 272-3966. The examiner can normally be reached on Monday to Thursday 8AM to 5PM and every other Friday.

51. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan J. Flynn can be reached on 571 272-1915. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

52. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. J./  
Examiner, Art Unit 2454

/Nathan J. Flynn/

**Supervisory Patent Examiner, Art Unit 2454**